

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 1-14 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 1-3, the Examiner objects to the phrase “a relative position of a reference position” because it is vague and indefinite. In response, claims 1 and 2 have been amended to merely refer to “a reference position” of a fixing frame. Claim 3 has been canceled.

With regard to claims 4, 5, 8 and 9, the Examiner argues that the phrase “such as” renders the claims indefinite. In response, claims 4, 5, 8 and 9 have been amended to delete the same as well as the limitation following the same.

Although not objected to, the term “or” has been removed from claims 4-9 and changed to recite “one of [feature A] and [feature B].”

Further with regard to claims 4 and 5, the Examiner argues that the phrase “the same processing as the formation of the image area” is vague and indefinite. Such phrase follows the phrase “such as” which has been canceled as discussed above.

With regard to claims 6 and 7, the Examiner does not understand how the phrase “by which a corner portion around the image area or at least a part of peripheral circuits of the image pick-up unit is viewed from the top” defines a shape of the fixing frame. In response, claims 6 and 7 have been amended to clarify the same. The amendment to claims 6 and 7 are fully supported in the original disclosure, for example from Figures 4 to 5B of the

drawings and the accompanying description of the specification. Thus, no new matter has been entered into the original disclosure by way of the amendment to claims 6 and 7.

Further with regard to claims 6 and 7, the Examiner also argues that the term “top” is ambiguous since there is no reference for its intended direction/location. In response, claims 6 and 7 have been amended to remove the term “top.”

With regard to claims 10 and 11, the Examiner makes several objections thereto. In response, claims 10 and 11 have been amended to clarify the same and to address the several objections thereto. The amendment to claims 10 and 11 are fully supported in the original disclosure. Thus, no new matter has been entered into the original disclosure by way of the amendment to claims 10 and 11.

With regard to claims 12 and 14, the Examiner argues that the terms “the inner diameter” and “the control operation” lack antecedent basis. In response, claims 12 and 14 have been amended to recite --an inner diameter-- and --a control operation--. Although not objected to, claim 13 has also been amended to provide an antecedent for the term “optical axis.”

Accordingly, it is respectfully requested that the rejection of claims 1-14 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner rejects claims 1-9 and 12-14 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0020810 to Takizawa et al., (hereinafter “Takizawa ”). Applicants note that claims 10 and 11 are not rejected and have also not been indicated as allowable.

In response, Applicants respectfully traverse the Examiner’s rejection under 35 U.S.C. § 102(e) for at least the reasons set forth below.

The Examiner rejects claim 1 based on the structure of Takizawa. Claim 1 is directed to a method of assembling a capsule endoscope. Thus, Applicants do not see how the structure of a capsule endoscope can disclose method steps for assembling the capsule endoscope. That is, those of ordinary skill in the art cannot determine the assembly steps for the capsule endoscope of Takizawa by the structure of the capsule endoscope disclosed therein. In particular, Applicants direct the Examiner to the positioning step of positioning the fixing frame so that it matches a reference position of an image area of the image pick-up unit. Takizawa does not even disclose or discuss the image area of the image pick-up unit and therefore cannot disclose or suggest such a positioning step.

For example, the same positioning step refers to the displaying of the reference frame (60a) on the display screen (59) and adjusting the table (53) so that the center position, size and /or orientation of the image of the image area (58a) taken by the camera (58) matches the image of the reference frame (60a). Takizawa simply does not disclose or suggest such a feature.

Independent claim 2 has similar limitations as claim 1 and is allowable for at least the same reasons as discussed above. Independent claim 3 has been canceled.

With regard to the rejection of claims 1-9 and 12-14 under 35 U.S.C. § 102(e), a assembling method of a capsule medical apparatus and a capsule medical apparatus having the features discussed above and as recited in independent claims 1 and 2, respectively, is nowhere disclosed in Takizawa. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claims 1 and 2 are not anticipated by

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

Takizawa. Accordingly, independent claims 1 and 2 patentably distinguish over Takizawa and are allowable. Claims 4-9 and 12-14 being dependent upon claims 1 and 2 are thus at least allowable therewith (claim 3 being canceled). Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-9 and 12-14 under 35 U.S.C. § 102(e).

Furthermore, the Applicants respectfully submit that at least dependent claims 10 and 11 patentably distinguish over Takizawa independently of their base claim. Takizawa simply does not disclose or suggest the positioning recited therein.

Lastly, new claim 32 has been added to further define the patentable invention. New claim 32 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claim 32. Applicants respectfully submit that new claim 32 is at least allowable as depending upon an allowable base claim (1).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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